

Notice of Allowability**Application No.**

10/624,061

Applicant(s)

FALCO ET AL.

Examiner

Phuong T. Bui

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to interview of 9/30/04.
2. ☒ The allowed claim(s) is/are 1 and 3-14.
3. ☒ The drawings filed on 21 July 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 6/30/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 9/30/04
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Kenneth Joung on September 30, 2004.

The application has been amended as follows:

In the specification, the following amendments were made:

The first line of the specification was replaced with "This application is a divisional of Application No. 09/454,279 filed December 3, 1999, now U.S. Patent No. 6,627,798, which claims benefit of Provisional Application No. 60/110,845 filed December 4, 1998, now expired."

In the claims, the following amendments were made:

In claim 1, line 4, "80%" was amended to -90%--.

Claim 2 was canceled.

The amendment to the specification is to update the status of Applicant priority benefit applications. The amendments to claims 1-2 are to avoid potential enablement and written description issues under 35 USC 112, first paragraph.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance: The claims are directed to an isolated polynucleotide comprising a nucleotide sequence encoding a polypeptide having chorismate mutase activity, wherein the polypeptide has at least 90% sequence identity with SEQ ID NO:16 based on the Clustal alignment method. SEQ ID NO:15 contains a complete open reading frame and encodes the full-length chorismate mutase enzyme of SEQ ID NO:16. Chorismate mutase is tyrosine biosynthetic enzyme that catalyzes the conversion of chorismate to prephenate (p. 1). The closest prior art teaches an *Arabidopsis thaliana* chorismate mutase having 59.8% sequence identity with SEQ ID NO:16 (Table 5, p. 21; also Eberhard et al., Plant J., 10:815-821, 1996 (Applicant's IDS)). It is noted that SEQ ID NO:15 encoding SEQ ID NO:16 was not disclosed in the provisional application. Accordingly, Applicant shall have priority benefit of the filing date of December 3, 1999. Since the closest prior art does not teach or suggest a sequence having 90% sequence identity with SEQ ID NO:16, the claimed invention is novel and unobvious in view of the prior art..

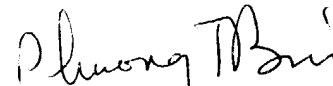
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong T. Bui whose telephone number is 571-272-0793. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phuong T. Bui
Primary Examiner
Art Unit 1638

9/30/04